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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,823	05/29/2001	Lalitha Agnihotri	US 010228	5093

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EXAMINER	
SHEPARD, JUSTIN E	

ART UNIT	PAPER NUMBER
2623	

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06/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/866,823	AGNIHOTRI ET AL.	
	Examiner	Art Unit	
	Justin E. Shepard	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 February 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

In view of the Appeal Brief filed on 2/5/07, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Scott Beliveau

SCOTT E. BELIVEAU
PRIMARY PATENT EXAMINER
Acting SPE

Response to Arguments

Applicant's arguments, see Appeal Brief, filed 2/5/07, with respect to claims 1 and 9 have been fully considered and are persuasive. The rejection of claims 1, 9, and any dependent claims have been withdrawn.

Applicant's arguments filed 2/5/07 referring to claims 17 and 18 have been fully considered but they are not persuasive.

Page 8, paragraph starting "First of all":

The applicant argues that the VRD cited by the examiner is not a "server comprising memory for storing a plurality of data files related to said plurality of video playback devices." The applicant is correct, although the "Internet Remote Control Host Server" cited (end of page 3 of the rejection) is a server comprising memory for storing a plurality of data files related to said plurality of video playback devices (paragraph 16).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Susskind.

Referring to claim 17, Susskind discloses a server (figure 1, part 12) for use in a communication network coupled to a plurality of video playback devices (figure 1, parts 10, 11 and 12), a server comprising a memory for storing plurality of data files related said plurality of video playback devices (paragraphs 15 and 16), wherein each of said plurality of data files comprises disk status indicator indicating an amount free space available on a disk drive in a selected one of said video playback devices (paragraph 35, lines 16-17).

Referring to claim 18, Susskind discloses a server as set forth in Claim 17 wherein each of said plurality of data files further comprises a recording schedule table indicating a list of television programs scheduled to be recorded by said selected one of said video playback devices (paragraphs 12 and 35).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsunomiya in view of Yap.

Referring to claim 1, Utsunomiya discloses a video playback device comprising: a disk storage device capable of storing (figure 1, parts 3 and 4; paragraph 43) television programs received from an external source (paragraph 40); a controller capable of receiving a first program recording command, wherein said first program recording command is operable to cause said controller to store a first television program on said disk storage device during a first time slot (figure 2, VCR1 – "EXECUTE RECORDING" signal); and a controller capable of determining if sufficient space is available on said disk storage device to store said first television program (figure 2, VCR1 – "MONITOR AVAILABLE CAPACITY"), wherein said disk storage device, in response to a determination that sufficient space is not available on said disk storage device is further capable of identifying in an external communication network (paragraph 39, lines 6-7; figure 2, VCR1 – "AVAILABLE CAPACITY LOW") a second remote video playback device capable of recording said first television program and transmitting a recording task request to said second remote video playback device (figure 2, VCR2 – "EXCECUTE RECORDING"; paragraph 51), wherein said recording task request is operable to cause said second remote video playback device to record said first television program during said first time slot (paragraph 50).

Utsunomiya does not disclose a device with a first controller capable of receiving a first program recording command; and a second controller capable of controlling said disk storage device.

In an analogous art, Yap teaches a device with a first controller capable of receiving a first program recording command; and a second controller capable of controlling said disk storage device (figure 3, parts 310 and 330; paragraph 26).

At the time of the invention it would have been obvious for one of ordinary skill in the art to use the separate controllers taught by Yap in the device disclosed by Utsunomiya. The motivation would have been to enable the system to be more robust by having a second processor able to perform the acts of the first (Yap: paragraph 26).

Claim 9 is rejected on the same grounds as claim 1.

Claims 2, 3, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsunomiya in view of Yap as applied to claims 1 and 9 above, and further in view of Potrebic.

Referring to claim 2, Utsunomiya discloses a device wherein a first storage device transfers the program recording to a second storage device (figure 2; paragraph 50).

Utsunomiya and Yap do not disclose a video playback device as set forth in Claim 1, wherein said second controller is further capable of comparing said first program recording command to a second program recording command previously received by said first controller and determining if a second time slot associated with said second program recording command overlaps said first time slot.

In an analogous art, Potrebic teaches a video playback device as set forth in Claim 1, wherein said second controller is further capable of comparing said first

program recording command to a second program recording command previously received by said first controller and determining if a second time slot associated with said second program recording command overlaps said first time slot (figure 4; column 9, lines 20-26 and 32-34).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the method to determine whether 2 requested programs overlapped, as taught by Potrebic, to the device disclosed by Utsunomiya and Yap. The motivation would have been that the system disclosed by Potrebic allows the recording of multiple programs with a single STB by using multiple tuners, while the system disclosed by Utsunomiya does not contain multiple tuners therefore only allowing the device to record overlapping programs.

Claim 10 is rejected on the same grounds as claim 2.

Referring to claim 3, Utsunomiya discloses a video playback device as set forth in Claim 2, wherein said second controller, further capable of accessing said second remote video playback device via said external communication network and transmitting said recording task request to said second remote video playback device, wherein said recording task request is operable cause said second remote video playback device record said first television program during said first time slot (figure 2; paragraph 50).

Utsunomiya and Yap do not disclose performing the above action in response to a determination that said first and second time slots overlap.

Potrebic discloses performing the above action in response to a determination that said first and second time slots overlap (figure 4; column 9, lines 20-26 and 32-34).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the method to determine whether 2 requested programs overlapped, as taught by Potrebic, to the device disclosed by Utsunomiya and Yap. The motivation would have been that the system disclosed by Potrebic allows the recording of multiple programs with a single STB by using multiple tuners, while the system disclosed by Utsunomiya does not contain multiple tuners therefore only allowing the device to record overlapping programs.

Claim 11 is rejected on the same grounds as claim 3.

3. Claims 4-8 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsunomiya in view of Yap in view of Potrebic as applied to the claims above, and further in view of Susskind.

Referring to claim 4, Utsunomiya, Yap and Potrebic do not disclose a video playback device as set forth in Claim 3, further comprising a memory for storing said first and second program recording commands in a recording schedule table.

In an analogous art, Susskind teaches a video playback device as set forth in Claim 3, further comprising a memory for storing said first and second program recording commands in a recording schedule table (paragraph 12).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the central database to hold individual recorder information taught by

Susskind to the previously disclosed device. The motivation would have been to store the information in a data format easily transmitted on a network enabling efficient data sharing.

Claim 12 is rejected on the same grounds as claim 4.

Referring to claim 5, Utsunomiya, Yap and Potrebic do not disclose a video playback device as set forth in Claim 3 wherein said second controller identifies said second remote video playback device by accessing a central server in said external communication network and requesting from said central server a list of remote video playback devices capable of recording said first television program.

In an analogous art, Susskind teaches a video playback device as set forth in Claim 3 wherein said second controller identifies said second remote video playback device by accessing a central server in said external communication network and requesting from said central server a list of remote video playback devices capable of recording said first television program (paragraph 12; paragraph 16).

At the time of the invention it would have been obvious for one of ordinary skill in the art to use the web server to identify a storage device, as taught by Susskind, in the device previously disclosed. The motivation would have been to allow people not living in the house to share recording space, thereby increasing the available storage space to a nearly infinite amount.

Claim 13 is rejected on the same grounds as claim 5.

Referring to claim 6, Utsunomiya, Yap and Potrebic do not disclose a video playback device as set forth in Claim 5 wherein said second controller is capable of transmitting to said central server disk space status information regarding an amount of available space on said disk storage device.

In an analogous art, Susskind teaches a video playback device as set forth in Claim 5 wherein said second controller is capable of transmitting to said central server disk space status information regarding an amount of available space on said disk storage device (paragraph 35; paragraph 16).

At the time of the invention it would have been obvious for one of ordinary skill in the art to use the web server to identify a storage device, as taught by Susskind, in the device previously disclosed. The motivation would have been to allow people not living in the house to share recording space, thereby increasing the available storage space to a nearly infinite amount.

Claim 14 is rejected on the same grounds as claim 6.

Referring to claim 7, Utsunomiya, Yap and Potrebic do not disclose a video playback device as set forth in Claim 6 wherein said second controller is further capable of transmitting to said central server a program recording schedule regarding television programs scheduled to be recorded by said video playback device.

In an analogous art, Susskind teaches a video playback device as set forth in Claim 6 wherein said second controller is further capable of transmitting to said central

server a program recording schedule regarding television programs scheduled to be recorded by said video playback device (paragraph 12; paragraph 16).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the central database to hold individual recorder information taught by Susskind to the previously disclosed device. The motivation would have been to allow people not living in the house to share recording space, thereby increasing the available storage space to a nearly infinite amount.

Claim 15 is rejected on the same grounds as claim 7.

Referring to claim 8, Utsunomiya, Yap and Potrebic do not disclose a video playback device as set forth in Claim 7 wherein said second controller is further capable of receiving from a third video playback device an incoming recording task request, wherein said incoming recording task request is operable to cause said video playback device to record a requested television program associated with said incoming recording task request.

In an analogous art, Susskind teaches a video playback device as set forth in Claim 7 wherein said second controller is further capable of receiving from a third video playback device an incoming recording task request, wherein said incoming recording task request is operable to cause said video playback device to record a requested television program associated with said incoming recording task request (figure 1, part 10).

At the time of the invention it would have been obvious for one of ordinary skill in the art to scale the system disclosed by Utsunomiya, Yap and Potrebic to more than 2 recorders as taught by Susskind. The motivation would be that the more recorders that were part of the system, the more total recording capacity the users would have in being able to records shows.

Claim 16 is rejected on the same grounds as claim 8.

4. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Susskind in view of Utsunomiya.

Referring to claim 19, Susskind does not disclose a server as set forth in claim 18, wherein said server is capable of receiving from a first one of said video playback devices a recording task request associated with a first television program, wherein said server, response receipt of said recording task request determines second one said video playback devices capable of recording said first television program.

In an analogous art, Utsunomiya teaches a server as set forth in claim 18, wherein said server is capable of receiving from a first one of said video playback devices a recording task request associated with a first television program, wherein said server, response receipt of said recording task request determines second one said video playback devices capable of recording said first television program (figure 2; paragraph 50).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the recording programs on other recorders method taught by Utsunomiya

to the server disclosed by Susskind. The motivation would have been to enable a program to be recorded in full even if the original recorder runs out of space (Utsunomiya: paragraph 3, lines 3-8).

5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Susskind in view of Utsunomiya as applied to claim 19 above, and further in view of Mitchell.

Referring to claim 20, Susskind in view of Utsunomiya does disclose a server as set forth in Claim 19 wherein said server transmits to said first video playback device a network address associated with said second video playback device.

In an analogous art, Mitchell teaches a server as set forth in Claim 19 wherein said server transmits to said first video playback device a network address associated with said second video playback device (Abstract: lines 3-5).

At the time of the invention it would have been obvious for one of ordinary skill to transmit the address of the recorder, as taught by Mitchell, in the system previously disclosed. The motivation would have been to enable the original recorder to obtain the recorded program after the recording has finished (Mitchell: Abstract: lines 6-9).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JS

SCOTT E. BELIVEAU
PRIMARY PATENT EXAMINER